# Supreme Court of the United States.

OCTOBER TERM, 1947.

JOHN D. PEDERSEN,
*Petitioner,*
*v.*
THE UNITED STATES,
*Defendant.*

## PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CLAIMS OF THE UNITED STATES.

*To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:*

Your petitioner, John D. Pedersen, respectfully prays for a writ of certiorari to the United States Court of Claims to review a judgment of that Court, entered October 6, 1947, dismissing plaintiff's petitions.

### Jurisdiction.

The date of the judgment to be reviewed is October 6, 1947, the date petitioner's petitions were dismissed. The statute giving jurisdiction is Section 288(b) of the Judicial Code. Jurisdiction of the Court in these cases is sustained in—

*Marconi Wireless Telegraph Co. of America* v. *United States,* 320 U.S. 1 (1942).

**Summary and Short Statement of the Matter Involved.**

These two suits were brought by John D. Pedersen, a resident of Jackson, Wyoming, and citizen of the United States, against the United States, in the Court of Claims. No. 45196 was brought for breach of a patent license contract to pay royalties for use of his inventions in semi-automatic rifles, for the period up to June 30, 1939, the date of cancellation of the contract by the United States, and was brought pursuant to Title 28, U.S. Code, Sec. 250(1). The original license contract with the petitioner was dated May 21, 1923, and was succeeded by a series of contracts, the last dated January 3, 1930.

No. 45182 was brought for infringement of three United States letters patent granted to the petitioner, No. 1,732,-949, issued October 22, 1929, for Cartridge Clip; No. 1,737,974, issued December 3, 1929, for Magazine Rifle; No. 1,804,511, issued May 12, 1931, for Combination of Cartridge Clip and Follower, for alleged infringement after June 30, 1939, the date of cancellation by the United States of its license contract with plaintiff, and was brought pursuant to Title 35, U.S. Code, Sec. 68.

The rifles manufactured by the United States on which the petitioner seeks compensation are the well-known M1 or Garand Semi-Automatic rifles used by the United States Army in World War II.

*The Court of Claims found that the United States had used petitioner's inventions and improvements and had infringed the patents, but denied all compensation under the contracts and held the patents invalid for want of invention.*

The petitioner is a noted independent gun designer, having designed many well-known Remington rifles, shotguns and pistols.

Beginning at least as early as 1903, the Ordnance Department of the United States Army had sought to develop a semi-automatic rifle* which would increase the firepower of the soldier, and replace the hand-operated Springfield M1903 rifle, used by the U.S. Army in World War I. Many rifles were submitted by gun designers throughout the world, the Ordnance Department developed others, but *all were unsatisfactory and all were rejected as failures. The problems of weight, strength, reliability and increased fire power remained unsolved,* and World War I had to be fought with the hand-operated Springfield M1903 (Findings 9 and 10).

In 1923 the Ordnance Department hired the petitioner as an independent contractor to develop a semi-automatic rifle under the contracts in suit, and gave the petitioner its facilities at its Springfield (Mass.) Armory. By May, 1926, petitioner completed the pilot model and, as a result of the satisfactory official tests, a new contract was made (June 1, 1926) hiring petitioner to build twenty additional rifles for further tests. These were completed in August, 1927, and from November, 1927, to April, 1928, they were exhaustively tested in nine phases by the Infantry Board at Fort Benning, Georgia, in competition with the hand-operated service rifle (Springfield M1903), and two rifles then being developed by the Ordnance Department† (see Finding 12). The Pedersen rifle clearly demonstrated its superiority and was recommended for official adoption.

*A semi-automatic or self-loading rifle is one which loads itself automatically from energy derived from the fired cartridge but which fires only one shot for each pull of the trigger. In the hand-operated rifle this loading is done manually by pulling back the bolt and pushing it forward again (see Findings 2-5).

†*I.e.,* Garand's primer-actuated rifle and General Thompson's Blish-actuated rifle—both charged from the old 5-round stripping clip, such as used in the Springfield M1903 (see Finding 12).

The Final Report of the Infantry Board (dated May 8, 1928) said:

> "a. That the advantages of the Pedersen rifle over the present Infantry armament, clearly demonstrated by this test, are such that further delay in the solution of the semi-automatic rifle problem is not justified.
>
> "b. That the Pedersen semi-automatic rifle cal. .276 be adopted as standard to completely replace the service rifle (M.1903) and the Browning automatic rifle and that it be included in the current program for manufacture." (Plf.'s Exh. 39.)

These tests showed that the Pedersen rifle and its novel charging system *increased the average rate of aimed fire from about ten shots per minute to about thirty shots per minute.* The features of the Pedersen rifle which made this increase in fire power possible were (Findings 11, 26, 28):

1. Pedersen's en-bloc clip, containing ten cartridges arranged in double rows in staggered relation, which clip with its cartridges was charged bodily into the magazine and which held the cartridges in a unitary mass both outside and inside the gun (described in Pedersen's Clip patent in suit No. 1,732,949; Finding 48).

2. Pedersen's magazine control system, whereby the clip is latched in the magazine until all the cartridges are fired, the follower pushes up the cartridges in the clip so that each cartridge can be fed successively into the firing chamber by the breech bolt (operated by the automatic breech mechanism) and, on the exhaustion of the cartridges in the clip, the breech opens and the bolt is locked open in its rear or open position by the bolt stop, and simultaneously the clip latch is automatically released and the clip is ejected, and the breech remains open until the

rifleman inserts and latches a fresh clip in the magazine. Locking the bolt back by the bolt stop prevents the bolt from interfering with the insertion of the fresh clip. This action is *wholly automatic* for the entire cycle. All that the rifleman has to do is to insert his clip of cartridges, aim the rifle, pull the trigger once for each shot until the cartridges are exhausted, and then insert a new clip. (Pedersen's magazine control system is described in his Rifle patent No. 1,737,974; Findings 26-28).

3. The Fort Benning tests showed the desirability of a *reversible clip,* which could be charged into the rifle with the high row of cartridges loaded on either the right or the left side in the clip. Pedersen subsequently developed his *shifting follower,* to accommodate such a clip (described in his Follower patent, No. 1,804,511; Findings 65-67). The shifting follower speeded up firing, because it enabled the soldier to charge the rifle without thought as to the arrangement of the cartridges in the clip.

In May, 1923, several types of automatic breech mechanisms which would eject a spent cartridge and reload automatically were already well known. The principal types were recoil-operated and gas-operated. Pedersen in his rifle employed a recoil-operated breech mechanism with a toggle-joint action.

**In July, 1926, after the successful tests of the pilot model of the Pedersen rifle, the Ordnance Department, without informing the petitioner, ordered John C. Garand, a civilian employee at Springfield Armory, to construct a model of a gas-operated semi-automatic rifle, but embodying Pedersen's double-row en-bloc clip and his magazine control system above described. This rifle, completed about July, 1929, became the M1 (Garand) rifle involved in this suit. This rifle differs from the Pedersen rifle only in the automatic breech mechanism employed and the slight changes required thereby. The Ordnance Department, through Garand,**

**merely substituted the well-known and equivalent gas-operated breech mechanism for Pedersen's recoil-operated toggle-joint breech mechanism, but otherwise copied the essential features of Pedersen's rifle, above described, responsible for its greatly increased fire power.**

*The equivalency of the Pedersen recoil-operated breech mechanism and the Garand (M1) gas-operated breech mechanism is beyond dispute.* Major (now Major-General) Julian C. Hatcher, in his story of the development of the semi-automatic rifle (M1, Garand), published in The American Rifleman of March, 1932, entitled: "The Military Semi-Automatic Rifle" (Plf.'s Exh. 46), states:

> "The next question is, How have we gone about making a semi-automatic rifle? How do we make the bolt operate automatically? *The answer is that there are quite a few different ways of accomplishing this.*
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> "[1. Short recoil operation.]
>
> "[2. Long recoil operation.]
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> . . . . . .
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> "A third very common system of operating automatic guns is to drill a hole in the barrel and take some of the hot gas under high pressure into a cylinder to push against a piston, thus making a sort of gas engine out of the gun [i.e. gas-operated]. An early example of this was Mr. Browning's first machine gun, the old Colt, which he invented in 1889.
>
> . . . . . .
>
> "These are the three main methods of operating machine guns and self-loading weapons of all kinds which use high-powered cartridges."

The "Confidential Digest of Activities of the Ordnance Department (at Springfield Armory), Month Ending March 31, 1925" (Plf.'s Exh. 52), also states (p. 12):

"Automatic small arms, such as machine guns of high power, have had their designs based upon two main systems of automatic action. *One system is operated by the recoil of the breech mechanism,* together with the barrel, the breech remaining locked until the bullet had left the barrel, and then unlocking automatically by various mechanical arrangements. Of this system, the two most successful weapons are the German Maxim and the Browning machine gun. *The other system is gas operated,* i.e., the pressure of the powder gases behind the bullet pass through a port near the muzzle of the gun and into a cylinder, forcing a piston to the rear, which, by a sequence of mechanical devices, unlocks and opens the breech. The two best known weapons based on this system are the French Hotchkiss machine gun, and the Browning automatic rifle."

After the Fort Benning tests showed the great superiority of the Pedersen rifle, the Ordnance Department then abandoned the two semi-automatic rifles it had previously been working on (*i.e.,* Garand's primer-actuated, and General Thompson's Blish-actuated rifle).

**The benefit to the United States from petitioner's work was very great. The M1 (Garand) gas-operated rifle was, of course, the principal arm of the United States soldier in World War II. It played an important part in winning the war. It was characterized by Major General George C. Patton, Jr., as "the greatest battle implement ever devised." With it United States troops enjoyed a 3-to-1 advantage in fire-power over enemy troops armed with the hand-operated magazine rifle (as German and Japanese troops were), and one division of United States troops so armed equalled in**

**fire-power three divisions of enemy troops. The benefit to the United States, its Army and its soldiers from the M1 semi-automatic rifle, was therefore enormous. But this great advantage in increased fire-power was due solely to petitioner's contributions—his double-row en-bloc clip charging system, his magazine control system, and shifting follower—all present in the M1 rifle. Without these features the M1 rifle was only another gas-operated semi-automatic rifle of a type already well known,* and not good enough to replace the hand-operated Springfield rifle (M1903).**

*Petitioner's contracts with the United States in suit* (Findings 6-8, pp. 4-11) hired the petitioner to develop a semi-automatic rifle for the Ordnance Department of the United States Army. For this work he was to be paid at the rate of $10,000 per year. But it was agreed that title to inventions and patents should remain in the petitioner, and that the United States had an option to acquire an exclusive license to manufacture, use and sell arms incorporating petitioner's inventions and developments and patented improvements, upon payment to petitioner of a royalty of $1.25 per gun up to a maximum of 400,000 guns (Art. V).

*The Ordnance Department, after the successful tests, exercised its option and acquired the exclusive license* in the contract dated August 27, 1928. The Ordnance Department has paid the petitioner the yearly salaries for his time as required by the contracts, *but has never paid the agreed royalty or any part of it, for use of petitioner's inventions, developments and improvements.*

In 1935 the Ordnance Department began building *in quantity* at Springfield Armory the 30-caliber gas-operated semi-automatic rifle now known as the M1 (Garand) rifle,

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*For instance, the French St. Etienne semi-automatic rifle of 1917, from which the M1 (Garand) is copied almost identically in its gas-operated automatic breech mechanism.

employing Pedersen's magazine control system, his en-bloc clip charging system and a shifting follower to permit use of a reversible clip (Finding 20).

On October 20, 1938, petitioner, by letter to Major General C. M. Wesson, Chief of Ordnance, notified the Ordnance Department that claims of the Pedersen patents "covered" the M1 (Garand) rifle and requested payment of royalties pursuant to the contract of January 3, 1930 (Finding 21). The Chief of Ordnance by letter to petitioner of April 20, 1939, then cancelled the existing contract and terminated the license agreement as of June 30, 1939, as permitted by the license agreement (Finding 22). *Thereafter the United States was no longer a licensee under petitioner's patents, but notwithstanding continued to make the M1 (Garand) rifles embodying the Pedersen inventions and improvements.*

The Chief of Ordnance, however, recognized the obligation under the license contract and on May 4, 1939, authorized payment to petitioner of the agreed royalty on "all guns manufactured under the license agreement" (Findings 23 and 24), and the Springfield Armory prepared vouchers for petitioner to sign, covering 13,024 M1 (Garand) rifles manufactured from 1935 to June 30, 1939, the payment to be $1.25 per rifle, or a total of $16,280 (Finding 24). Each voucher stated:

> "For payment of fee in accordance with the license agreement contained in contract W852-ord-6, dated Jan. 3, 1930."

When the vouchers were presented for payment to the General Accounting Office, the Comptroller-General refused payment on the ground that the M1 (Garand) rifle was not the Pedersen rifle (Finding 25)—not realizing, as the Ordnance Department did, that the M1 rifle did em-

body Pedersen's inventions and improvements with a gas-operated breech mechanism substituted for Pedersen's recoil-operated toggle-joint mechanism.

Petitioner then brought these suits.

*As to the Contract Suit,* the Court of Claims held that the M1 (Garand) rifle was not the Pedersen rifle and therefore there was no obligation to pay the agreed royalty of $1.25 per rifle, relying upon difference in outward appearance of the two rifles and the fact that different automatic breech mechanisms were used. The Court readily acknowledged (Findings 20, 30-33, 50, 70-71) that the M1 rifle embodied and used petitioner's inventions and improvements, *i.e.,* his double-row en-bloc clip charging system, his magazine control system, and a shifting follower—but, because a gas-operated breech mechanism was used in place of Pedersen's recoil-operated breech mechanism, recognized no obligation on the part of the United States to pay for the use of petitioner's inventions and improvements, under the contracts in suit.

*As to the Patent Infringement Suit,* the Court, while acknowledging that the patents were infringed, held all the infringed claims invalid for lack of invention and anticipation by the prior art.

THE COURT OF CLAIMS HAS ALLOWED THE GOVERNMENT TO CONFISCATE PETITIONER'S PROPERTY WITHOUT COMPENSATION AND WITHOUT DUE PROCESS OF LAW.

The Government undeniably (Findings, 20, 30-33, 50, 70-71) has used petitioner's inventions and improvements in the M1 (Garand) rifle—his double-row en-bloc clip charging system, his magazine control system, and the

shifting follower. They can be seen physically present in the M1 rifle (Plf.'s Exh. 5). Undeniably the Government and the nation have greatly benefited by using them. In denying any obligation to pay for petitioner's contributions, the Court has treated petitioner most unjustly and unfairly and has allowed the Government to seize his property for public use without compensation.

1. *The Contract Suit.* The pertinent part of the last contract, of January 3, 1930, Article IV (Finding 8), reads as follows:

> "Article IV. The right and title to any patents secured by the contractor upon inventions disclosed to the United States in connection with the development and manufacture of the semi-automatic rifle, or upon any invention which the contractor may make during the period of the design and construction of the rifle, shall be and remain exclusively with the contractor, except that in consideration of this agreement and the payments which may be made under it, *the contractor hereby grants to the United States an exclusive license to manufacture or cause to be manufactured, and use and sell in accordance with existing law, arms incorporating the inventions and developments disclosed under this contract, or any patented improvements thereon subsequently granted said contractor.* It is to be understood that this contract shall be interpreted as dealing with rights under United States patents only.
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> "This exclusive license shall permit the United States to manufacture or cause to be manufactured, and use and sell in accordance with existing law, *this arm* upon payment to the party of the first part of a royalty of One Dollar and Twenty-five cents ($1.25) per gun up to a maximum of Four Hundred Thousand

(400,000) guns, after which royalty payments shall cease, and the United States shall then have a non-exclusive license to manufacture or cause to be manufactured and to use and sell in accordance with existing law the arms in consideration of the prior payments."

*The Court grievously misconstrued the contract.* "This arm," on which the United States agreed to pay petitioner a royalty of $1.25 per gun up to 400,000 guns, refers back to the previous paragraph, which describes the *arms* the Government was licensed to manufacture, use and sell as "*arms incorporating the inventions and developments disclosed under this contract, or any patented improvements thereon subsequently granted said contractor.*" Petitioner made *four* inventions in his semi-automatic rifle, all of which he disclosed to the Ordnance Department under the contract and all of which were patented. The Government used *three* of them in the M1 (Garand) rifle—the double-row en-bloc clip, the magazine control system, and the shifting follower. The Government did not use the *fourth*—Pedersen's recoil-operated toggle-joint breech mechanism—but in its place substituted an old, well-known, fully equivalent gas-operated breech mechanism. The contract does not require the Government to use *all* of petitioner's inventions and improvements and in the exact form disclosed before it is obligated to pay the agreed compensation. The Government still used *three* of petitioner's inventions and improvements essential to the success of the rifle, and the equivalent of the *fourth*. We submit that it is contrary to all law and justice for the Court of Claims to construe the contract to hold there is no obligation to pay the agreed compensation under such circumstances.

The Court of Claims completely misunderstood the true situation. It merely said (p. 78):

> "The two guns are generally speaking not alike then, in either appearance, construction or operation, *except in those particulars in which any two semi-automatic shoulder rifles would, it would seem, have to be alike.*"

**But no other semi-automatic ever was like petitioner's in using Pedersen's double-row en-bloc clip charging system, his magazine control system and shifting follower, except the M1 (Garand) rifle. These were Pedersen's contributions. In the entire record the only semi-automatic rifles having these features are petitioner's rifle and the M1 (Garand) rifle.**

2. *The Patent Infringement Suit.* In holding the infringed claims of petitioner's patents all invalid for lack of invention the Court wholly disregarded the petitioner's uncontradicted evidence of invention:

(1) That a problem of long standing existed and that there had been many unsuccessful attempts to solve it.*

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*The Digest of Activities of the Ordnance Department, Month Ending March 31, 1925 (Plf.'s Exh. 52), states (p. 12):

> "*For years inventors have attempted to design a semi-automatic shoulder rifle to take the place of the Springfield. One of the main difficulties was the weight and size limits, together with the great power of our service cartridge.*"

Major (now Brigadier-General) G. H. Drewry's article "Our New Service Rifle" (Plf.'s Exh. 47) states (p. 5):

> "Every model tested (by the Ordnance Department) to that date (1924) was rejected for failing to meet these speci-

(2) That the Government abandoned its own attempts to solve the problem, and immediately adopted Pedersen's solution when the tests showed Pedersen had successfully solved it.

No one before had perceived the changes necessary to be made in prior-art structures to meet the requirements of a successful semi-automatic rifle. Pedersen succeeded where every one else had failed. All the usual indicia on which the Courts rely to find invention and that petitioner's solution of the problem was not obvious are present here, but were ignored by the Court of Claims. The Court made no findings on this very material point. *It is most unfair to petitioner to ignore this record of past failures, and untrue in fact to hold these things obvious to anyone, as the Court has done, merely to relieve the Government of responsibility for paying for its use of petitioner's inventions.*

The prior-art patents relied on to invalidate the Pedersen patents were merely the failures of the past, which contributed nothing to the development of the semi-automatic rifle. *None of them even showed a semi-automatic rifle.* If Pedersen's contributions had been obvious, as the Court now holds, a successful semi-automatic rifle would most certainly have been produced long before by the Ordnance Department, without having to hire petitioner to develop it for them. On the Court's theory, the Wright Brothers' airplane patent would be invalid for lack of in-

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fications in one or more respects, *which is eloquent testimony as to the difficulties encountered by designers.*"

Major (now Major General) Julian S. Hatcher's article "The Military Semi-Automatic Rifle" (Plf.'s Exh. 46) said (p. 14):

> "*A great many years ago the Army recognized the desirability of the semi-automatic rifle, but for many years little success attended the efforts to design such a weapon.*"

vention, and anticipated by the prior-art airplanes that could not even get off the ground.

*The Rifle patent* was held invalid upon von Wehrstedt's United States patent No. 468,394 of 1892 (Findings 40-41), and the von Frommer British patent No. 101,037 of 1916 (Findings 36-37) and on Lantz United States patent No. 477,128 of 1892 (Findings 42-44). The findings are not sustained by the evidence. The Court failed to construe Pedersen's claims in the light of his specifications. The von Wehrstedt and von Frommer patents show merely a hand-operated rifle of the old Mannlicher type in which the rifleman operates the breech bolt by hand, and do not sustain the finding. The Lantz patent also shows a hand-operated rifle which is so hopelessly impractical as to require three hands to operate it. None of these hand-operated rifles contributed anything to the development of a successful semi-automatic rifle. To arrive at its conclusion of invalidity the Court of Claims ignored the language of Claims 33, 34 and 35, which requires "clip discharge mechanism *having an automatic operation*," *i.e.*, that of a semi-automatic and not a hand-operated rifle. The Court then found present in the Lantz patent, mechanism which could not possibly be called a *bolt stop* nor operate as one within the meaning of Pedersen's patent (Claims 24 and 30). The findings (Nos. 42-44) are contrary to the Court's own definition of a bolt stop used by it in describing the Pedersen rifle (Findings 11, 19, 26-28).

*The Clip patent* was held invalid on a double-row en-bloc clip disclosed in Frey (Swiss) patent of 1891, although that patent does not disclose or describe the vertical and lateral pressure on the cartridges which are features which made the Pedersen clip a success and which have been adopted by the United States in the M1 (Garand) clip (Finding 62). The findings are not sustained by the evidence.

*The Follower patent* was held invalid on the disclosures of Mondragon of 1907 and Lewis of 1883, which could not possibly operate as a shifting follower in the manner required by the claims (Finding 73)—even reversing the Commissioner, who had found this patent valid and not anticipated. The finding is not sustained by the evidence.

The Court of Claims has unfairly used a double standard of comparison in dealing with the Pedersen patents—one for the M1 (Garand) rifle, and another for the prior art. When comparing the M1 (Garand) rifle with the Pedersen rifle, the Court had great difficulty in seeing similarities between the two rifles merely because they differed in their automatic breech mechanisms, and made the following statement:

> "But in appearance at least, and in the large working parts of the two guns, there is little resemblance, almost as little as there could be between two semi-automatic shoulder rifles. . . ." (Opinion, pp. 77-78.)

But when comparing the Pedersen claims with the prior art, it readily found identical structure in totally dissimilar hand-operated rifles and in the failures of the past. Yet in the entire record the only rifle similar to Pedersen's —*i.e., semi-automatic,* using Pedersen's double-row en-bloc clip charging system, magazine control system and shifting follower—was the M1 (Garand) rifle.

*The Government's liability based on implied contract still remains.* The Court's holding all the patents in suit invalid for lack of invention, despite the overwhelming and uncontradicted evidence to the contrary, cannot terminate the Government's liability for use of the petitioner's improvements and inventions based on *implied contract. This obligation to prevent unjust enrichment still exists.*

But the Court has already denied one motion by petitioner to file an amended complaint to recover reasonable compensation for the use of petitioner's improvements and inventions, based on *implied contract* and *quantum meruit*.

We submit that the Court of Claims has been most unfair and unjust to the petitioner here. *The Government has boldly appropriated and used petitioner's improvements and inventions and should pay compensation for that use as it agreed.* Otherwise the Government takes petitioner's property for public use without compensation. The Government's obligation is clear beyond any question —on express contract, for patent infringement, and on implied contract. Yet the Court has dismissed the petitions, on findings wholly unsupported by the evidence and contrary to the evidence.

It is apparent from this case that the Court of Claims feels that its sole obligation is owed to the Government, that its only duty is to save the Government money—regardless of the merits of the citizen's claim, or the injustice to the claimant—and is imbued with the doctrine that "the King can do no wrong." Such an outworn dogma has no place in the United States. It is apparent that the Court of Claims has forgotten the reason for its own existence—to give the citizen a fair and impartial tribunal in which to present claims for compensation against his Government. The Court's conduct is no less unjust if it grants small claims but denies large ones equally meritorious.

As a result of the Court of Claims decision—

(1) The Court has allowed the Government to confiscate a citizen's property for public use without compensation and without due process of law—and to evade its just obligation to make payment for the use of inventions and improvements it induced the petitioner to make for the Government, in violation of the Fifth Amendment to the

Federal Constitution, which states: "Nor shall private property be taken for public use, without just compensation." It is no justification that the claim for compensation is justly a large one; the benefit to the nation was enormously greater.

(2) There is no review provided by law by appeal from the Court of Claims. It is a trial Court, but its decision on law and fact is ordinarily final. Unless this Court will exercise its discretionary jurisdiction, there can be no review to rectify a flagrant injustice. The petitioner, we submit, has been most shamefully and ungratefully treated by his Government, and in a manner not in accord with the American tradition of fair play.

(3) The action of the Court of Claims in this case—in declaring petitioner's patents invalid for lack of invention and as obvious, and ignoring petitioner's uncontradicted evidence of long-existing problems which had defeated the gun designers of the world for decades—effectively nullifies Title 35, U.S. Code, Sec. 68,* and renders worthless the remedy provided by Congress to the patent-owner whose inventions have been used by the Government. The statute gives the patent-owner a remedy for infringement by suit against the United States in the Court of Claims. That remedy, provided to prevent confiscation of a patent-owner's property without compensation and without due process of law, now becomes worthless if the decision in this case is allowed to stand as a precedent. The remedy may

*Title 35, U.S. Code, Sec. 68, provides in part:

> "Whenever an invention described in and covered by a patent of the United States shall hereafter be used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, such owner's remedy shall be by suit against the United States in the Court of Caims for the recovery of his reasonable and entire compensation for such use and manufacture."

as well not exist, if it is to be administered as it has been in this case. Otherwise it becomes a snare and a delusion, an utter waste of the patent-owner's time, effort and money.

**Questions Raised by the Case.**

The questions raised by the case are simple and fundamental:

1. Is the Government obligated, like a private contracting party, to pay agreed compensation according to contract for developments, inventions and improvements which it hires to be made, and which it adopts and uses to its great benefit?

2. Can the Court of Claims disregard uncontradicted evidence of existing problems which have baffled men skilled in the art for many years and the Government's immediate adoption of the patented solution and hold the patents invalid for want of invention, thus nullifying Title 35, U.S. Code, Sec. 68, as a remedy for patent infringement by the Government and depriving the patentee of its property?

3. Can the Court of Claims, by disregarding all evidence of invention, in effect thus seize the petitioner's inventions for public use, without just compensation?

4. Can the Government, by the device of declaring invalid patents on which it is sued for infringement, and which it has admittedly infringed, avoid liability based on *implied* contract to pay compensation for inventions and improvements which it hired to be made, and has used to its great benefit?

**Reasons Relied on for the Allowance of the Writ.**

Your petitioner respectfully prays that the writ be allowed for the following reasons:

1. Because the decision of the Court of Claims conflicts with the settled rules of contract law that a party hiring work to be done for agreed compensation, which is then performed pursuant to the agreement, is obligated to pay the agreed compensation therefor. This rule applies to the Government as well as private contracting parties. The Court of Claims has grievously misconstrued the contract.

2. Because the decision of the Court of Claims in effect allows the Government to appropriate and obtain the benefit of the petitioner's property without compensation, in violation of the Fifth Amendment to the Federal Constitution.

3. Because there is no review by appeal provided by law from the decisions of the Court of Claims, which is a trial Court. The decision of the Court of Claims herein is contrary to settled principles of law and to the evidence herein, and most unfair to the petitioner, but these errors cannot be corrected, unless this Court will exercise its discretionary jurisdiction.

4. Because the decision of the Court of Claims herein in holding the petitioner's patents in suit invalid, despite the evidence of the long-existing problems which the Ordnance Department and gun designers throughout the world were unable to solve in years of constant effort, which shows that petitioner's successful solutions could not be regarded as obvious, nullifies Title 35, U.S. Code, Sec. 68, which confers jurisdiction of patent infringement claims against the Government on that Court, and renders useless and worthless the remedy thereby provided.

**Specification of Errors.**

1. The Court of Claims erred in holding the United States was not obligated to pay petitioner the agreed compensation for use of petitioner's inventions and improvements pursuant to the patent license contract of January 3, 1930, and preceding contracts.

2. The Court of Claims erred in holding claims 33, 34 and 35 of petitioner's Rifle patent No. 1,737,974 invalid as anticipated by the hand-operated rifles of von Frommer British patent No. 101,037 of 1916 and von Wehrstedt United States patent No. 468,394 of 1892, which holding is not sustained by the evidence.

3. The Court of Claims erred in holding claims 24 and 30 of petitioner's Rifle patent No. 1,737,974 invalid as anticipated by the hand-operated rifle of United States patent to Lantz No. 477,128 of 1892, which holding is not sustained by the evidence.

4. The Court of Claims erred in holding claims 1, 2, 6, 7, 8 and 10 of petitioner's Clip patent No. 1,732,949 invalid as anticipated by Frey Swiss patent No. 3432 of 1891, and claim 3 invalid if infringed, and claim 13 not infringed, which holdings are not sustained by the evidence.

5. The Court of Claims erred in holding claims 1, 2, 5 and 6 of petitioner's Follower patent No. 1,804,511 invalid for lack of invention and anticipation by Lewis United States patent No. 283,122 of 1883 and Mondragon No. 853,715 of 1907, which holdings are not sustained by the evidence.

6. The Court of Claims erred in denying petitioner's motion to file an amended complaint seeking compensation for use of petitioner's inventions and improvements based on implied contract or quantum meruit.

**Conclusion.**

The petitioner was engaged by the Ordnance Department of the United States Army to develop a semi-automatic rifle for it, when its own efforts of twenty years had failed. The petitioner produced the first and enormously successful rifle, which increased the fire-power of the soldier three-fold. That rifle, with the substitution of a well-known, and fully equivalent, gas-operated breech mechanism became the great M1 semi-automatic rifle used by United States troops in World War II, "the greatest battle implement ever devised" (General Patton). The petitioner fulfilled his part of the contract—and the United States has greatly benefited by his contributions. But now the Court of Claims holds there is no obligation on the part of the United States to pay for petitioner's great contributions on express contract, for patent infringement, or on implied contract. To avoid liability for patent infringement the Court has declared the patents invalid for lack of invention and as obvious, despite the uncontradicted evidence that petitioner had succeeded in solving the many problems involved where all others had failed.

The petitioner has been a great benefactor of the United States—but the story of the ungrateful and unfair treatment he has received from his Government is most shameful and disheartening. It is scarcely a story likely to induce other inventors to forsake gainful private employment and respond to their country's call when a great invention is needed, and to devote the best years of their lives to the nation's service, as petitioner did. This Court is the last bulwark for preservation of the citizen's rights against his Government, as expressed in our Bill of Rights—"*nor shall private property be taken for public use, without just compensation*" (Fifth Amendment to the Constitution).

WHEREFORE your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the United States Court of Claims, commanding that Court to certify and to send to this Court for its review and determination, on a day certain to be named therein, a full and complete transcript of record and of proceedings in the cases numbered and entitled on its docket Nos. 45196 and 45182, *John D. Pedersen, Petitioner,* v. *The United States, Defendant,* and that your petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet and just; and your petitioner will ever pray.

Respectfully submitted,

JOSEPH B. ELY,

GEORGE P. DIKE,

Attorneys for the Petitioner.

CEDRIC W. PORTER,

FREDERICK M. KINGSBURY,

Of Counsel.

# Supreme Court of the United States.

OCTOBER TERM, 1947.

No. 515.

JOHN D. PEDERSEN,
*Petitioner,*
*v.*
THE UNITED STATES,
*Defendant.*

## PETITIONER'S REPLY BRIEF ON PETITION FOR WRIT OF CERTIORARI TO THE COURT OF CLAIMS.

The Government's Brief in Opposition to the petition misstates petitioner's claims in several important respects. An opportunity to reply briefly is respectfully requested.

On page 2, the question presented by the Contract Suit is incorrectly and unfairly stated. We submit it is correctly and fairly stated thus:

1. Whether the contract obligates the United States to pay petitioner the agreed royalties for the manufacture of a semi-automatic rifle incorporating inventions and improvements disclosed and contributed by the petitioner, which the United States admittedly has used to its great advantage in a rifle differing from petitioner's rifle only in substituting a well-known, and fully equivalent, gas-operated breech mechanism in place of petitioner's recoil-operated breech mechanism?

**Reply to Argument—Pages 15-18.**

There is no requirement in the Contracts that petitioner's inventions and developments, which the United States was licensed to use, must subsequently be sustained as "*valid inventions*" before the United States is obligated to pay the agreed royalty, and no provision that a decision of any court holding petitioner's patents *invalid* would relieve the United States of its obligation under the Contracts. Yet the Court of Claims and the Government's Brief so interpret the Contracts. The petitioner asserts that the Contracts cannot be so interpreted, and that the United States is obligated under the Contracts to pay the agreed royalty for petitioner's improvements used by the United States, regardless of the holding by the Court of Claims that the patented improvements are not "valid inventions." *Indeed, it is settled law that the United States, like any other licensee, is estopped to deny the validity of any patents under which it is licensed.*

See *United States* v. *Harvey Steel Co.*, 196 U.S. 310 (1904).

The Ordnance Department did not have to use the petitioner's improvements embodied in his rifle—the double row en-bloc clip, the magazine control system and shifting follower. It used them only because its tests had established that these improvements were essential to the increased fire power the Ordnance Department was seeking in a semi-automatic rifle. It was optional whether the rifle in which they were used have a *recoil-operated,* or a *gas-operated* breech mechanism. The Ordnance Department subsequently chose the gas-operated breech mechanism. But, using the very features essential to the success of the rifle which petitioner contributed, it is utterly unconscionable, and grievously misconstrues the Con-

tracts for the Court of Claims to avoid the obligation to pay the agreed compensation, by the device of holding the patents invalid for lack of invention, despite the overwhelming evidence to the contrary.

The findings of invalidity of the patents in the patent infringement suit are not sustained by the evidence. They are based on old hand-operated rifles and on the failures of the past. They ignored petitioner's uncontradicted evidence of invention, namely, the Ordnance Department's failure to produce a satisfactory semi-automatic rifle notwithstanding twenty years of constant effort, and the immediate adoption of petitioner's mechanisms when the tests showed that the problem had been successfully solved for the first time.

But the findings of invalidity of the patents in suit do not discharge the Government's obligation to pay the petitioners reasonable compensation for the use of petitioner's improvements, after June 30, 1939, the date of cancellation of the license contract in suit. *The obligation, based on implied contract, still remains.* But the Court of Claims has denied petitioner even this remedy by denying a motion to file an amended complaint based on *implied contract.*

The result is that the United States, by the contracts in suit, induced the petitioner to devote his great skill and experience to devising a semi-automatic rifle, on the promise that, if the Government used the improvements, the Government would pay an agreed royalty of $1.25 per gun up to 400,000 guns for an exclusive license to manufacture, use and sell *"arms incorporating the inventions and developments disclosed under this contract or any patented improvements thereon subsequently granted said contractor."* The petitioner fully performed his part of the undertaking. The Government has used petitioner's inventions and improvements to its enormous benefit, but has

failed to pay the agreed compensation. By so doing the Government has taken the petitioner's "*private property for public use, without just compensation,*" in violation of its own solemn contract, and in plain and clear violation of the Fifth Amendment to the Constitution. But Constitutional guarantees of the citizen's rights against his Government, as expressed in the Bill of Rights, are worthless and empty words, unless the Courts will protect and enforce them.

We respectfully submit that the petition for the writ of certiorari to the Court of Claims in these cases, *John D. Pedersen* v. *United States,* Nos. 45196 and 45182, should be granted.

Respectfully submitted,
JOSEPH B. ELY,
GEORGE P. DIKE,
Attorneys for the Petitioner.

CEDRIC W. PORTER,
FREDERICK M. KINGSBURY,
Of Counsel.

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# In the Supreme Court of the United States

OCTOBER TERM, 1947

No. 515

JOHN D. PEDERSEN, PETITIONER

*v.*

THE UNITED STATES

*ON PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CLAIMS*

## BRIEF FOR THE UNITED STATES IN OPPOSITION

### OPINION BELOW

The opinion of the Court of Claims (R. 104–113) is not yet officially reported.

### JURISDICTION

The judgment of the Court of Claims was entered on October 6, 1947 (R. 114). The petition for a writ of certiorari was filed on January 5, 1948. The jurisdiction of this Court is invoked under Section 3 (b) of the Act of February 13, 1925, as amended by the Act of May 22, 1939.

### QUESTIONS PRESENTED

The United States contracted with petitioner for the design of a semiautomatic shoulder arm.

Among other things, the contract provided that patents on all inventions made during the design and construction of the semiautomatic rifle would be the property of petitioner, that the United States would have an exclusive license to the use of these inventions, and that the exclusive license would permit the United States to manufacture "this arm" upon payment of a royalty of $1.25 per gun up to a maximum of 400,000 guns. The questions presented are:

1. Whether the contract obligates the United States to pay petitioner royalties for the manufacture of a semiautomatic rifle, not developed by petitioner and differing from petitioner's design in appearance, structure, and operation, because some features were within the terminology of certain invalid claims of petitioner's patents.

2. Whether there is substantial evidence to support the findings of the Court of Claims that the claims of petitioner's patents alleged to have been infringed either did not involve invention over the prior art or were not infringed.

## STATEMENT

Petitioner, a gun designer, brought two suits in the Court of Claims, which were subsequently consolidated, based upon the alleged use by the United States of petitioner's patents in the manufacture of the M–1 or Garand .30 cal. semiautomatic rifle (R. 1, 11, 104). Petitioner sought to recover royalties under a contract and compensa-

tion for the unauthorized use of his patented inventions after cancellation of the contract (R. 29). Holding that most of petitioner's claims did not involve invention and that the others were not infringed, the court below denied any recovery (R. 104).

The special findings of fact of the Court of Claims (R. 30–104) may be summarized as follows:

On May 21, 1923, petitioner entered into a contract with the United States for the development of a semiautomatic rifle (R. 32). The contract provided, among other things, that petitioner would disclose the work he had already done toward inventing and designing a semiautomatic gun and for one year from June 1, 1923, would "actively engage in the completion of the design and invention of this arm" (R. 33). Petitioner was to receive compensation in the amount of $10,000 for the year and was to retain ownership of any patents upon inventions disclosed or made in connection with the development of the semiautomatic rifle (R. 33–34). The United States was to receive an exclusive license to manufacture "this arm" upon payment of a royalty of $1.25 per gun up to a maximum of 400,000 guns (R. 34). Thereafter, the United States was to have a nonexclusive license to manufacture without payment of royalties (R. 34–35). The Government had the right to renew the license annually and an election to continue the license was to be implied unless

the Government gave notice of termination (R. 35). It was also agreed that the name "Pedersen" would appear on each arm manufactured by the United States under this agreement (R. 35). Similar contracts were made each successive year and the final contract was entered January 3, 1930 (R. 36).[1] This contract recited that a semiautomatic shoulder arm delivered under the contract of June 1, 1925, and 20 delivered under the contract of June 1, 1927, had passed several tests. It also recited that the construction of an improved arm embodying certain necessary or desirable changes in the type already delivered had been begun under the 1927 contract and continued under successive contracts but had not yet been completed (R. 37). The 1930 contract provided that petitioner would complete the design and building of the improved arm not later than December 31, 1930 (R. 38). The provisions of the contract with respect to patents, licenses, and royalties remained the same as in the earlier contracts (R. 38–39).

During the period when petitioner was developing and perfecting his semiautomatic rifle, the Ordnance Department was also developing and testing a semiautomatic rifle which was being designed by John C. Garand, a civilian employee

[1] In April 1928 the contract then in effect was cancelled by mutual agreement to enable petitioner to go to England in connection with some design work (R. 36). He returned after several months and the contracts were renewed (R. 36).

at the Ordnance Department, and another semiautomatic rifle designed by Brigadier General John T. Thompson (Fdg. 12, R. 41). Both of these semiautomatic rifles as first designed were charged with five .30 calibre cartridges from the standard stripping clip (R. 42). The Pedersen rifle was loaded with ten .276 calibre cartridges by an "*en bloc*" clip (R. 41, 42). During this period of development, the Garand, Thompson, and Pedersen rifles were subjected to comparative firing tests by the Ordnance Department (R. 42). As early as June 1926, a comparative report of the three rifles was made by the Infantry Board at Fort Benning, Georgia, and improvements were recommended with respect to each (R. 42–43). Another comparative report was made in February 1928, and a final report on the Pedersen rifle in May 1928 recommended its adoption with modifications (R. 44–46).

During the progress of the development work, petitioner filed applications which matured into patents entitled "Magazine Rifle," "Cartridge Clip," and "Combination of Cartridge Clip and Follower," the three patents on which these suits are based (R. 46–47). The "Magazine Rifle" patent relates to a mechanism for the release of the empty cartridge clip and its automatic ejection after the last cartridge has been fired and to a bolt lock mechanism which holds the breech bolt in a rearward position after the last cartridge has been fired and the cartridge clip ejected (R. 47).

The "Cartridge Clip" patent describes an *en bloc* cartridge clip for holding a double row of cartridges in staggered relationship (R. 47). The "Combination of Cartridge Clip and Follower" also discloses an *en bloc* cartridge clip holding a double row of cartridges with the addition of a follower designed to provide a self-adjusting step for supporting the staggered rows of cartridges regardless of whether the bottom cartridge in the clip is in the right or left row (R. 47).

Sometime prior to 1938 the United States began the manufacture of a semiautomatic rifle known as the M–1 or Garand rifle and *en bloc* cartridge clips for it (R. 47). The Garand rifle incorporated a mechanism for automatically ejecting the empty clip after the firing of the last cartridge and for locking the bolt in the rearward or open position (R. 48). This rifle also used an *en bloc* clip which held two rows of cartridges in staggered relationship (R. 48). In letters of October 20, 1938, and February 21, 1939, to the Chief of Ordnance, petitioner claimed that the Garand rifle contained features covered by his patents and requested the payment of royalties under the contract of January 3, 1930 (R. 48). By letter dated April 20, 1939, the Chief of Ordnance terminated the license agreement effective June 30, 1939 (R. 49). In response to a subsequent letter, the Chief of Ordnance advised petitioners that vouchers for guns manufactured through June 30, 1939, would be submitted to the General Accounting Office for

direct settlement but that the submission of vouchers was not "to be construed as an acknowledgment of the validity of your patents" (R. 49–50). The vouchers did not indicate on their face the approval of the Ordnance Department (R. 50). On January 10, 1940, the Comptroller General refused payment of the vouchers on the ground that the contract provided for the payment of royalties only if the semiautomatic rifle designed and developed by petitioner was manufactured by the United States, and that the Garand rifle and not that designed by petitioner had been adopted by the United States Army as standard equipment (R. 50–52). Petitioner thereafter brought one suit for breach of the patent license contract (R. 11) and another for compensation for the unauthorized use of his patents (R. 1).

The court below found that the Garand rifle was not the gun developed by petitioner (R. 103–104) and differed radically from it in many respects. See note 2, *infra,* pp. 16–17. Petitioner based his right to compensation in both suits on the ground that the Garand rifle embodied claims under the three patents previously mentioned. The claims asserted under the three patents, which are twenty in number, are discussed in detail in the findings. This summary statement will not deal individually with each of the claims but only with the principal features of the three patents and the related findings of the court below.

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The principal features of the "Magazine Rifle" patent which are in issue are a bolt stop for holding the bolt in its rearward position after the firing of the last cartridge, a latch for retaining the cartridge clip in position, and mechanisms for releasing and ejecting the empty cartridge clip (R. 52). Similar features occur in the Garand rifle (R. 61–62). Although the preferred embodiment of the Pedersen rifle disclosed in the specification is a gun of the semiautomatic type which employs an *en bloc* clip holding two rows of cartridges in staggered relationship, the claims in suit are couched in broad phraseology and do not specifiy any particular type of gun or cartridge clip and do not include any timing release of the clip other than to indicate that it is controlled by the exhaustion of cartridges in the clip (R. 65). The claims with respect to "automatic operation" (R. 57–58) merely refer to the automatic discharge of the cartridge clip upon the exhaustion of cartridges in the clip and the rearward positioning of the bolt (R. 65).

More than two years prior to the filing of petitioner's application there were available in the art eight United States patents, two German patents and two British patents (R. 63). Among these the Von Frommer (British) patent (R. 65) discloses a rifle in which the clip discharge mechanism is self-acting or automatic in operation and is controlled by the exhaustion of cartridges in the clip and by a subsequent positioning of the

breech bolt rearwardly (R. 67). Similar claims of petitioner's rifle patent are, therefore, anticipated by the Von Frommer disclosure (R. 67). The Gundlach (German) patent (R. 67) discloses a gun having a breech action comprising a reciprocating bolt and magazine chamber containing a clip of cartridges, a clip discharge mechanism tending to discharge said clip, a latch for restraining the discharge of said clip, and a cartridge feeding means which, upon exhaustion of cartridges in the clip, acts to release the latch and to permit the discharge of the clip by the clip discharge mechanism (R. 68). Comparable claims of petitioner are thus anticipated by the Gundlach patent (R. 68). The Von Wehrstedt (United States) patent (R. 68) discloses a breech loading magazine gun having a reciprocating breech bolt, a magazine chamber which is adapted to contain a clip of cartridges, a latch for retaining the clip in position, a clip discharge mechanism tending to discharge the clip, and a follower mechanism operating to feed the cartridges from the clip (R. 70). The clip discharge mechanism is arranged to discharge automatically the clip upwardly out of the magazine chamber and past the breech action upon retraction of the breech bolt after the last shot is fired, and is controlled by the exhaustion of cartridges in the clip and by the subsequent positioning of the bolt rearwardly in the receiver (R. 70). Thus numerous of petitioner's claims are also anticipated by the

Von Wehrstedt disclosure (R. 70). The Lantz (United States) patent (R. 70) discloses a gun having a bolt movable back and forth, a bolt stop operable for holding the bolt in its rear position, a clip of cartridges, a latch for retaining the clip of cartridges in position for loading, and a cartridge feeding means mounted on the gun independently of the clip (R. 74). The cartridge feeding means acts upon the exhaustion of cartridges in the clip to release the latch and also to actuate the bolt stop into its bolt holding position (R. 74). Petitioner's bolt stop claims are thus anticipated by the Lantz patent and do not present any patentable novelty over the prior art (R. 74). All of petitioner's claims under his rifle patent are therefore anticipated in the Von Frommer, Gundlach, Von Wehrstedt, and Lantz patents, and are void of patentable novelty (R. 76).

The "Cartridge Clip" patent comprises a U-shaped sheet metal clip constructed to hold a stack of cartridges in a tight compact package, the clip being adapted to be loaded into the magazine of the gun together with the cartridges (R. 76). The patent emphasizes as an important feature of novelty that the stack of cartridges contained in the clip is in a double row and that the clip is so constructed that it will hold the cartridge securely and in fixed relationship under all usual conditions of handling (R. 76). The clip is described as made of sheet metal or stamp-

ing possessing the requisite degree of strength, springiness, and lightness to accomplish the purpose for which it is designed (R. 77). Other than this the specification does not contain any specific instructions as to the thickness and kind of material of which the clip is to be made (R. 77). The clip disclosed in the patent is nonreversible in character, having a definite top and bottom which renders it capable of being introduced in the gun only in the one position (R. 77). It comprises a back and two sides designed to exert a lateral pressure on the cartridges in the clip (R. 77–78).

The alleged infringing structure used in the Garand rifle is a U-shaped clip made of sheet metal having a back wall and two forewardly extending sides (R. 80). When loaded it contains a stack of cartridges arranged in two rows in staggered relationship (R. 80). The Garand clip differs from that disclosed in petitioner's patent in that, being entirely symmetrical in structure, it is reversible, so that it may be inserted in the magazine chamber of the gun without respect to which is the top or bottom (R. 80), and may be loaded with a double staggered row of cartridges without particular attention to which side contains the high row (R. 81).

Although two of petitioner's claims under his cartridge clip patent were held not applicable to the Garand clip, the remaining claims were held applicable (R. 81–82). In connection with the

applicable claims, fifteen United States patents, one British patent, and one Swiss patent were available to those skilled in the art more than two years prior to the filing of petitioner's patent application (R. 82–83). The prior art disclosed in these patents reveals that the basic idea of packaging cartridges in sheet metal clips or containers adaptable for insertion into a rifle is relatively old (R. 83). Thirteen patents issued from 1888 to 1911 relate to the subject of cartridge clips (R. 83). Four of these disclose cartridge clips or packages which contain two rows of cartridges in staggered relationship (R. 83). Several prior patents disclose U-shaped sheet metal clips and cartridge retaining ribs (R. 84–86). Other patents also disclose a detachable magazine containing two rows of cartridges in staggered relationship or an integral one-piece *en bloc* cartridge clip for holding a stack of cartridges in a double row in mutually engaged relationship (R. 86–92). For example, the Mondragon (United States) patent discloses a reversible type integral one-piece *en bloc* cartridge clip constructed for the purpose of containing a stack of cartridges in a double row which resembles the Garand clip in that it is symmetrical in form and may be loaded with either row high (R. 89). The Frey (Swiss) patent also discloses a reversible *en bloc* cartridge clip for holding a stack of cartridges in a double row which is similar to the Garand clip in that it is symmetri-

cal in form and is capable of being loaded with either row high (R. 90). In connection with the prior art disclosures in other patents, all of the infringed claims under petitioner's clip patent are anticipated by the Frey disclosure and are invalid for anticipation and lack of invention (R. 92).

Petitioner's "Combination of Cartridge Clip and Follower" patent disclosed a reversible cartridge clip and a cooperating follower (R. 93). The clip, which held a double-row stack of cartridges in staggered relation, was symmetrical so that either side might be charged into the magazine (R. 94). The follower, which supported and fed the cartridges through the magazine, contained a step which shifted automatically as necessary to a right or left-hand position, so that the follower would accommodate the staggered cartridges in the clip, supporting both rows, regardless of which side was low (R. 94). Petitioner's claims related principally to this feature of the patent (R. 96–97). The Garand reversible clip is also used in connection with a follower which employs a different mechanism from petitioner's to support the low row of cartridges in the staggered arrangement regardless of whether it is on the right or left side; the evidence is in conflict as to whether or not a shifting element or slide in the Garand follower also supports the high row (R. 98).

Five United States and one Swiss patent were available in the prior art more than two years prior to petitioner's application for the clip and follower patent (R. 98–99). The Lewis (United States) patent (R. 99) discloses a follower mounted on springs which is sufficiently flexible to permit it to be tilted automatically to engage the bottom cartridge in the clip whether it be on the right or left side (R. 100). The Mondragon (United States) patent (R. 101) discloses a follower which does not shift but which, by means of two symmetrical grooves at the top of the follower, engages the bottom cartridge of the two staggered rows regardless of which side is low (R. 102). Although neither of these patents discloses a shifting support for the upper row of cartridges, the Mondragon clip and follower, with the mere mechanical addition of the Lewis shifting element to support the upper row of cartridges, anticipates all the claims of petitioner's clip and follower patent (Fdg. 75, R. 102–103).

To summarize, Garand or M–1 rifles which used *en bloc* clips were manufactured by or for the United States before the termination of its contract with petitioner effective June 30, 1939. Although these Garand rifles and clips come within the terminology of certain claims of two of petitioner's three patents, the Garand rifle is not the gun developed by petitioner within the meaning of his contract with the United States (Fdg. 78,

R. 103–104). Moreover, all the claims of the rifle patent alleged to be infringed are invalid. All but two of the claims of the clip patent alleged to be infringed are invalid. One of these two is not infringed and the other, if interpreted broadly enough to be infringed, is invalid. All the claims of the clip and follower patent alleged to be infringed are invalid. (Fdg. 79, R. 104.)

On the foregoing findings of fact the Court of Claims concluded as a matter of law that petitioner was not entitled to recover and dismissed the suits (R. 104). The court interpreted the contract as one calling for the payment of a specified royalty only if the Army manufactured a gun developed by petitioner and not a rifle developed by someone else, differing in appearance, construction, and operation from petitioner's, but which incorporated some features old in the art upon which petitioner held invalid patents (R. 108–109). No validly patented detail of petitioner's rifle was found to be infringed by the Garand rifle (R. 113).

## ARGUMENT

The interpretation of the contract provisions as obligating the United States to pay royalties, in addition to annual compensation of $10,000, only if petitioner's gun was adopted or, at most, only if the gun adopted incorporated valid patents of petitioner, seems wholly consonant with the terms of the agreement. It does not appear that peti-

tioner contends otherwise. Although petitioner urges that the court misconstrued the contract, the alleged error appears to be based on the assumption that some of his inventions were used and that the court required that all be used (Pet. 12). As we have seen, the court found that none of the claims of petitioner's patents that appeared in the Garand rifle involved valid invention. The court's further conclusion that the Garand rifle was not petitioner's design is best supported by its own description of the differences between the two guns (R. 107–108).[2]

[2] "We have said that the plaintiff's claim in the royalty contract case that the Garand rifle is in fact the Pedersen rifle is apparently based upon the incorporation in the Garand rifle of devices upon which the plaintiff claims he holds patents. It is probably true that the plaintiff would have been entitled to royalties under his contract if the Government had copied his rifle, even though his rifle had involved no inventions, or, if it did, he had taken out no patents upon them. But in appearance at least, and in the large working parts of the two guns, there is little resemblance, almost as little as there could be between two semiautomatic shoulder rifles. Perhaps the first thing to be decided in the design of a semiautomatic weapon is how to obtain the power to operate the mechanism. Pedersen obtained his power from the rearward push of the cartridge case when the power exploded. In his gun patent he said that one advantage of this was that it saved the weight and bulk of a tube slung under the barrel to carry force from the compression in the barrel between the cartridge case and the bullet. Yet Garand used the tube device, with its added weight and bulk, after having worked, in earlier models, with a third method, that of taking power from the explosion of the primer. Both

Since petitioner nowhere specifically asserts a right to recover regardless of invention, the only issue which appears to be presented is that of the validity of petitioner's patents. This is traditionally a question of fact. *United States* v. *Esnault-Pelterie,* 303 U. S. 26, 29; *United States* v. *Esnault-Pelterie,* 299 U. S. 201, 205. The court below in 79 special findings (R. 29–104) has closely scrutinized petitioner's patents, the claims under

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Pedersen's method and that of Garand were old in the art, but they were completely different from each other, and each required different designing of other parts of the gun to cooperate with the method used. An apparent instance is the fact that Pedersen's bolt could not be positively locked in position to hold the cartridge in the chamber, since it had to be free to yield to the rearward motion of the cartridge case as the bullet left it, while Garand's bolt is positively so locked, and is only set free by a turning motion produced by the gas pressure created by the bullet the instant before it leaves the barrel. The Pedersen bolt works on a toggle which throws it almost vertical when it is in its rearward position. The Garand bolt slides straight back. The Pedersen bolt remains locked back when a clip of cartridges is exhausted and until a new clip is completely inserted, and then is released only by a separate manual pull backward. The Garand bolt is released as the inserted clip reaches its final position and is latched in and the operator's thumb is pushed aside forcefully by the return of the bolt to its closed position. The Pedersen gun has an extensive covering of metal meshing around the barrel to cool it. The Garand gun has no such device.

"The two guns are generally speaking not alike then, in either appearance, construction or operation, except in those particulars in which any two semiautomatic shoulder rifles would, it would seem, have to be alike. * * *" (R. 107–108).

them, the alleged infringements, and the patents in the prior art. These claims and their relation to prior inventions are specifically discussed with meticulous care. The studied analysis of the court below clearly supports its ultimate finding that all claims involving infringement lack invention over the prior art. It is well settled that in the absence of a conflict of decision, the issue of invention does not present a question for review by this Court. *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314; *Layne & Co.* v. *Western Well Works*, 261 U. S. 387; *General Pictures Co.* v. *Electric Co.*, 304 U. S. 175, 178–179. There are no circumstances in this case which would warrant a departure from that rule.

## CONCLUSION

The judgment of the court below is clearly correct and there is no conflict of decisions. The petition for a writ of certiorari should, therefore, be denied.

Respectfully submitted.

PHILIP B. PERLMAN,
*Solicitor General.*
H. G. MORISON,
*Assistant Attorney General.*
PAUL A. SWEENEY,
MORTON LIFTIN,
*Attorneys.*

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